REMARKS/ARGUMENTS

The Final Office Action of December 15, 2006, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-6, 8-9, and 11-40 remain pending. Applicants have not amended the claims but include a copy merely for the convenience of the Examiner.

Rejections under 35 U.S.C. §102

Claims 1-40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gerace (International Publication No. WO 97/41673, hereinafter referred to as *Gerace*). Applicants respectfully traverse the rejection.

In order establish a prima facie case of anticipation under 35 U.S.C. § 102(b), each and every feature of the claim must be taught by the reference. *Gerace* describes a method and system for targeting of appropriate audiences based on psychographic or behavioral profiles of end users. (*Abstract*). *Gerace* uses agate information to determine the profile of a computer user, and in particular the behavioral or psychographic profile of a user. (p. 3, ll. 2-5). The *Gerace* system includes a tracking and profiling member for recording user activity including presentation (format) preferences of users such as a User Object to track user actions in a history profiling table. (p. 3, ll. 8-19 and p. 4, ll. 23-25, and reference element program 31). For each and every user, the program 31 of the *Gerace* patent creates a user profile from the agate information viewing habits of the user. (p. 7, ll. 19-21). Advertisements are then displayed to users in accordance with the psychographic profile of the user. (p. 3, ll. 28-31). The system generates a custom Home Page, including a user's preferred agate information based upon the user profile. Under the *Gerace* system, user activity is monitored in order to create a user profile and advertisements are then shown based upon this user profile.

Gerace fails to teach or suggest every feature of Applicants' claim 1. Applicants' claim 1 recites, among other features "wherein no user profiling data is forwarded to the advertising server." As recited in Applicants' claim 1, at least one applet reads textual content displayed on the web browser and the advertising server compares the read textual content to keyword data to determine whether display an ad on the web browser. No data is forwarded to the advertising

server. As described in Applicants' original written description, user privacy is a concern and tracking and generation of a user profile would not be desired, as opposed to the *Gerace* system. (See Applicants' original written description, paragraphs **[10]** – **[11]**, **[13]**, and **[15]**). The *Gerace* system requires generation of a user profile in order to generate a custom Home Page for a user. Under the *Gerace* system, advertisements are only displayed based upon the generated user profile.

Still further, the Action admits this requirement of the *Gerace* system. "The user's psychographic profile and demographic profile are collected from the user during a registration or an enrollment or sign-up process. Thereafter, the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity." (Action, p. 3). Applicants' claim 1 is patently distinct from *Gerace* for at least the reason that *Gerace* forwards user profiling data.

In addition and in response to Applicants' response to the non-final Office Action of June 30, 2006, the Action unduly limits the claim language. Specifically, the Action states,

> as long as the user's profile data are not collected and provided to an external advertising server 140 or external party, the claim limitation or claim amendment is met. Indeed, in the prior art of record (the Gerace's or Graham's), the advertising server is part of the internal system and hence, the user's profile data are not collected and provided to any third party or external advertising server, but rather collected and used internally for targeting the users contrary to the Applicants' contention. (Action, p. 10).

Applicants disagree with the limitations that the Action places on the claim language of claim 1. Specifically, Applicants' claim 1 feature, "wherein no user profiling data is forwarded to the advertising server," recites nothing as to the advertising server being of a third party or external. The Action's attempt to limit the claim language to being external from a designated internal system or providing to a third party is wrong as such a limitation is simply not within the claim. As specifically admitted by the Action in the above portion, "the user's profile data ... [are] collected and used internally for targeting the users." Contrary to the comments and limitations of the Action, *Gerace* does forward user profiling data to an advertising server 27, the same advertising server 27 that allegedly sends the at least one applet. "Each sponsor has one ore more ad packages maintained by respective Ad Package Objects 33b of the sponsor. In each Ad

Package Object 33b (Fig. 5b) there is indicated the sponsor ID, start and end dates and times, and pricing of the ad packages....<u>Ad Package Object 33b records the number of hits and click throughs as tracked/monitored during user operation of the program.</u>" (*Gerace*, p. 22, l. 36 to p. 23, l. 14, emphasis added).

Therefore, because *Gerace* fails to teach or suggest each and every feature of Applicants' claim 1, withdrawal of the present rejection is respectfully requested.

Claims 2-6, 8-9, 11-20, and 31-34, which depend from claim 1, are allowable over the art of record for all the reasons given above concerning their respective base claim, and further in view of the novel features recited therein. For example, Applicants' claim 5 recites, "said web browser is a Java™ enabled web browser," claim 6 recites, "said at least one applet is a Java™ applet," and claim 7 recites, "a servlet that facilitates communication between said at least one applet and said advertising server." No portion of *Gerace* teaches or suggests at least these features of Applicants' claims 5-7.

Still further, Applicants' dependent claim 34 recites, among other features, "wherein no data is collected to profile a user of the web browser." As explicitly admitted in the Action, "the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity." (Action, p. 3). By the very operation of *Gerace*, user data must be collected and used for the psychographic profiling. Therefore, *Gerace*, by its very operation, cannot perform the features of Applicants' claim 34. As such, for at least this additional reason, *Gerace* fails to teach or suggest the features of Applicants' claim 34.

Applicants' claims 21, 30, and 37 include similar language as recited above with respect to Applicants' claim 1. For at least similar reasons as recited above with respect to Applicants' claim 1, *Gerace* fails to teach or suggest every feature of Applicants' claims 21, 30, and 37. As such, Applicants' claims 21, 30, and 37 are allowable over the art of record. Applicants' claims 22-29 and 35, 36, and 38-40, which depend from claims 21, 30, and 37, respectively, are allowable over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein. In addition, as described above with respect to Applicants' claim 34, *Gerace*, by its very operation, cannot perform the features of

Applicants' claims 35 and 36. As such, for at least this additional reason, *Gerace* fails to teach or suggest the features of Applicants' claims 35 and 36.

Claims 1-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Graham et al. (U.S. Patent No. 6,804,659, hereinafter referred to as *Graham*). Applicants respectfully traverse the rejection.

In order establish a prima facie case of anticipation under 35 U.S.C. § 102(e), each and every feature of the claim must be taught by the reference. *Graham* describes an internet target marketing method and system for distributing online advertising to viewers based upon the viewers' interests. (*Abstract*). As with the *Gerace* system described above, the *Graham* system uses a personal profile of a user. (Col. 6, ll. 7-11). The *Graham* system includes a concept comparator 106 that compares user concept output 20 from profile content recognizer 102 and advertiser concept output 22 from advertisement concept recognizer 104 to produce as an output a "best ad," 30, an advertisement targeted to the user of client browser 12a based on the content of the document, the user's interests and the content of the advertisements. (Col. 5, ll. 58-64). Advertisements are then displayed to users based on user's concepts of interest. (Col. 6, l. 17). Even the content of the document is based upon the user selectable concepts of interest. (Col. 7, ll. 50-53). As part of the process of analyzing a document to identify discussion corresponding to one or more user selectable concepts of interest, reference in *Graham* is made to FIGs. 5-8. (Col. 8, ll. 46-51).

In description of FIG. 5, the *Graham* system utilizes an annotation agent 508 that depends on inputs by a user. The concepts of interest and other user-specific information are maintained in a user profile file 516. (Col. 11, ll. 23-31). Then, particular patterns in parsed text are determined by the contents of user profile 516 (col. 11, ll. 57-60), and a Bayesian belief network 700 uses user profile file 516 for source in order to ultimately output an advertisement (col. 12, ll. 52-55). Under the *Graham* system, a user profile file is created and advertisements are then shown based upon this user profile file.

Graham fails to teach or suggest every feature of Applicants' claim 1. Applicants' claim 1 recites, among other features, "wherein no user profiling data is forwarded to the advertising server." As recited in Applicants' claim 1, at least one applet reads textual content displayed on

the web browser and the advertising server compares the read textual content to keyword data to determine whether display an ad on the web browser. No data is forwarded to the advertising server. The *Graham* system requires generation of a user profile file in order to generate an advertisement for a user. Under the *Graham* system, advertisements are only displayed based upon the generated user profile file.

Applicants' claim 1 is patently distinct from *Graham* for at least the reason that *Graham* displays ads based upon a user profile file forwarded to an ads database. Applicants' disagree with the limitations that the Action places on the claim language of claim 1. At page 9, the Action states, "Here, the advertising server is part of the internal system and hence, the user's profile data are not collected and provided to any third party or external advertising server, rather are collected and used internally for targeting the users." Specifically, Applicants' claim 1 feature, "wherein no user profiling data is forwarded to the advertising server," recites nothing as to the advertising server being of a third party or external. The Action's attempt to limit the claim language to being external from a designated internal system or providing to a third party is wrong as such a limitation is simply not within the claim. Therefore, because *Graham* fails to teach or suggest each and every feature of Applicants' claim 1, withdrawal of the present rejection is respectfully requested.

Claims 2-6, 8-9, 11-20, and 31-34, which depend from claim 1, are allowable over the art of record for all the reasons given above concerning their respective base claim, and further in view of the novel features recited therein. For example, Applicants' claim 5 recites, "said web browser is a Java™ enabled web browser," claim 6 recites, "said at least one applet is a Java™ applet," and claim 7 recites, "a servlet that facilitates communication between said at least one applet and said advertising server." No portion of *Graham* teaches or suggests at least these features of Applicants' claims 5-7. Still further, Applicants' dependent claim 34 recites, among other features, "wherein no data is collected to profile a user of the web browser." As explicitly admitted in the Action, "the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity." (Action, p. 3). As such, for at least this additional reason, *Graham* fails to teach or suggest the features of Applicants' claim 34.

Applicants' claims 21, 30, and 37 include similar language as recited above with respect to Applicants' claim 1. For at least similar reasons as recited above with respect to Applicants' claim 1, *Graham* fails to teach or suggest every feature of Applicants' claims 21, 30, and 37. As such, Applicants' claims 21, 30, and 37 are allowable over the art of record. Applicants' claims 22-29 and 35, 36, and 38-40, which depend from claims 21, 30, and 37, are allowable over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. If any additional required fees are or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Date: February 28, 2007

By: /John M. Fleming/
John M. Fleming
Registration No. 56,536

1001 G Street, N.W.
Eleventh Floor
Washington, D.C. 20001-4597
(202) 824-3000